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### REMARKS

Claims 1-14, 16-19 and 52-53 and 55-92 are currently pending. Claims 15 and 52 have been canceled. Claims 1-3, 52 and 56 are amended herein. Support for amended Claim 1 is found at [109] and originally filed Claim 15. Support for amended Claim 2 is found at paragraphs [0054], [103], [109], [115] of the specification. Support for amended Claim 52 is found at paragraphs [0054], [103], [109], [115] and previously filed Claim 54. Accordingly, Claims 1-14, 16-19, 52-53 and 55-92 are presented herein for further consideration by the Examiner.

### Response to Judicially Created Obviousness-Type Double Patenting

The Examiner rejected Claims 1, 3, 5, 12, 14-17, 52-54, 57 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,676,883 (the '883 patent) in view of U.S. Patent No. 4,731,266 to Bonnebat et al. The Examiner rejected Claim 2 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the '883 patent. The Examiner rejected Claims 4-7, 9-12, and 19 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 31, 32, and 34-38 of the '883 patent in view of U.S. Patent No. 4,505,951 to Kennedy. The Examiner rejected Claims 6, 8, and 13 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 31, 32, and 34-38 of the '883 patent in view of U.S. Patent No. 4,573,429 to Cobbs, Jr. et al. The Examiner rejected Claim 18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 31, 32, and 34-38 of the '883 patent in view of U.S. Patent No. 6,350,796 to Dworak et al. Applicants have amended Claims 1, 3 and 52 and respectfully submit that the Claims recite feature which over novel and nonobvious combinations of elements over the cited prior art.

#### Claim 1

The claims of the '883 patent do not disclose each and every limitation of amended Claim 1. Nor do the secondary references cited by the Examiner teach or suggest the deficiencies of the '883 patent. For example, amended Claim 1 of the present application recites, among other things, that the first coating is an inner coating layer comprising a first thermoplastic epoxy resin and the second coating comprises a different coating material than the

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first thermoplastic epoxy resin. Hence, Applicants respectfully request that the nonstatutory double patenting rejection of Claim 1 be removed.

Claims 3-14 and 16-19 depend from Claim 1 and further define what is claimed in Claim 1. Claims 3-14 and 16-19 are patentably distinguished over the cited claims and secondary references for at least the reasons set forth above with respect to Claim 1, as well as for novel and nonobvious features recited therein.

#### Claim 2

The claims of the '883 patent do not disclose each and every limitation of amended Claim 2. Nor do the secondary references cited by the Examiner teach or suggest the deficiencies of the '883 patent. For example, amended Claim 2 of the present application recites, among other things, that the first thermoplastic epoxy resin consists essentially of a Phenoxy-type thermoplastic resin and the second coating layer material disposed on the first coating layer is selected from the group consisting of coating material selected from the group consisting of polyester, acrylic, a second thermoplastic epoxy resin that is different from the first thermoplastic epoxy resin, paraffin, wax, polysilane and low molecular weight polyethylene. Hence, Applicants respectfully request that the nonstatutory double patenting rejection of Claim 1 be removed.

#### Claim 52

The claims of the '883 patent do not disclose each and every limitation of Claim 52. Nor do the secondary references cited by the Examiner teach or suggest the deficiencies of the '883 patent. For example, amended Claim 52 of the present application recites, among other things, applying an aqueous solution or dispersion of a first phenoxy-type thermoplastic and applying an aqueous solution or dispersion of a second thermoplastic resin coating material selected from the group consisting of polyester, acrylic, a second thermoplastic epoxy resin that is different from the first thermoplastic epoxy resin, paraffin, wax, polysilane and low molecular weight polyethylene. Hence, Applicants respectfully request that the nonstatutory double patenting rejection of Claim 52 be removed.

Claims 53 and 55-57 depend from Claim 52 and further define the invention defined in Claim 52. Claims 53 and 55-57 are patentably distinguished over the cited claims and secondary

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references for at least the reasons set forth above with respect to Claim 1, as well as for novel and nonobvious features recited therein.

**Response to Rejections under 35 U.S.C. § 102 and/or § 103**

The Examiner rejected Claim 2 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Kennedy. The Examiner rejected Claims 1-2, 4-9, 11, 14, 19, 52-53, and 57 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,393,106 to Maruhashi. The Examiner rejected Claims 3, 19, 55, 56 under 35 U.S.C. § 103(a) as obvious over Maruhashi. The Examiner rejected Claims 8 and 13 under 35 U.S.C. § 103(a) as unpatentable over Maruhashi in view of U.S. Patent No. 4,573,429 to Cobbs Jr. et al. The Examiner rejected Claims 10 and 12 as obvious over Maruhashi in view of Kennedy. The Examiner rejected Claims 5-17 and 54 under 35 U.S.C. § 103(a) as unpatentable over Maruhashi in view of Farha. The Examiner rejected Claim 18 under 35 U.S.C. § 103(a) as unpatentable over Maruhashi in view of Farha further in view of U.S. Patent No. 6,350,796 to Dworak et al. Applicants respectfully submit that the pending claims are in condition for allowance for at least the reasons detailed below.

**Claim 2 is allowable over Kennedy**

The Examiner rejected Claim 2 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Kennedy. The cited reference, alone or in combination, does not teach or suggest each and every limitation of Claim 2. For example, amended Claim 2 of the present application recites, among other things, that the first thermoplastic epoxy resin consists essentially of a Phenoxy-type thermoplastic resin and the second coating layer material disposed on the first coating layer is selected from the group consisting of coating material selected from the group consisting of polyester, acrylic, a second thermoplastic epoxy resin that is different from the first thermoplastic epoxy resin, paraffin, wax, polysilane and low molecular weight polyethylene. Hence, Claim 2 is in condition for allowance.

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Claims 1-2, 4-9, 11, 14, 19, 52-53 and 57 are allowable over Maruhashi

The Examiner rejected Claims 1-2, 4-9, 11, 14, 19, 52-53, and 57 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,393,106 to Maruhashi. Applicants have amended independent Claims 1, 2 and 52 and respectfully submit that the amended claims recite features which are not disclosed by Maruhashi.

The *Office Action* also fails to set forth a *prima facie* case of obviousness of these claims because it fails to set forth the required clear and particular showing that Maruhashi and the secondary references suggest the desirability of making the claimed combination of elements. The Court of Appeals for the Federal Circuit has explained that to sustain an obviousness rejection "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

Claim 1

Each and every element of the independent Claim 1 is not explicitly or inherently disclosed in Maruhashi. For example, Claim 1 that the first coating is an inner coating layer comprises a first thermoplastic epoxy resin and the second coating comprises a different coating material than the first thermoplastic epoxy resin. As the Examiner states in paragraph 11 of the Office Action, "Maruhashi fails to teach that more than one layer of later or epoxy resin coating are applied." Thus, Maruhashi does not disclose that an inner coating layer comprises a first inner coating layer and that a second, *different* thermoplastic epoxy resin is further disposed on the article.

Maruhashi also does not remotely teach or suggest the limitations of the claim as amended. There is no indicated in Maruhashi to reapply a coating composition, either of the same thermoplastic epoxy resin or a different thermoplastic epoxy resin. For the amended claim limitations, the Examiner has not made a particular finding as to a reason the skilled artisan would selected the combination of two different thermoplastic epoxy materials. Therefore, the Examiner has not set forth a *prima facie* case of obviousness.

Thus, Maruhashi does not disclose each and every limitation of Claim 1, and Applicants respectfully submit that Claim 1 is in condition for allowance. Claims 3-19 depend from Claim 1 and further define the invention defined in Claim 1. Claims 3-19 are patentably distinguished

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over the cited claims and secondary references for at least the reasons set forth above with respect to Claim 1, as well as for novel and nonobvious features recited therein.

#### Claim 2

Maruhashi, alone or in combination with the secondary references, does not teach or suggest each and every limitation of Claim 2. For example, amended Claim 2 of the present application recites, among other things, that the first thermoplastic epoxy resin consists essentially of a Phenoxy-type thermoplastic resin and the second coating layer material disposed on the first coating layer comprises a coating material selected from the group consisting of polyester, acrylic, a second thermoplastic epoxy resin that is different from the first thermoplastic epoxy resin, paraffin, wax, polysilane and low molecular weight polyethylene. As the Examiner found in paragraph 14 of the Office Action, Maruhashi fails to teach that the epoxy resin coating comprises phenoxy resins. Therefore, each and every limitation of Claim 2 is not taught or suggested by Maruhashi.

The Examiner cited Farha as a reference that discloses phenoxy-type thermoplastic as "suitable for forming an outer layer of a multilayer coated PET bottles." Applicants respectfully submit that Maruhashi and Farha, alone or in combination, do not teach or suggest each and every limitation of Claim 2. For example, Claim 2, discloses applying an aqueous solution/dispersion of a first thermoplastic Phenoxy-type thermoplastic resin by dip, spray, or flow coating and applying an aqueous solution or dispersion of a second thermoplastic resin selected from the group consisting of coating material selected from the group consisting of polyester, acrylic, a second thermoplastic epoxy resin that is different from the first thermoplastic epoxy resin, paraffin, wax, polysilane and low molecular weight polyethylene, on an outer surface of an article substrate by dip, spray, or flow coating. The Examiner has not identified that Maruhashi or Farha teach or suggest that aqueous solutions/dispersions of Phenoxy-type thermoplastics can be applied to performs. Therefore, Applicants respectfully request that the examiner withdraw the rejection and earnestly solicit the allowance of Claim 2.

#### Claim 52

Each and ever element of the independent Claim 52 is not explicitly or inherently disclosed in Maruhashi. Amended Claim 52 of the present application recites "applying an

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aqueous solution or dispersion of a first phenoxy type thermoplastic resin on an outer surface of a body portion of the preform by dip coating, spray coating, flow coating, or combinations thereof" and "applying an aqueous solution or dispersion of a coating material selected from the group consisting of polyester, acrylic, a second thermoplastic epoxy resin that is different from the first thermoplastic epoxy resin, paraffin, wax, polysilane and low molecular weight polyethylene on the substantially dried first coating of the preform by dip coating, spray coating, flow coating, or combination thereof."

Maruhashi, alone or in combination does not teach or suggest each and every limitation of Claim 2. As the Examiner found in paragraph 14 of the Office Action, Maruhashi fails to teach that the epoxy resin coating comprises phenoxy resins. The Examiner cited Farha as a reference that discloses phenoxy-type thermoplastic as "suitable for forming an outer layer of a multilayer coated PET bottles." However, Applicants respectfully submit that the Maruhashi or Farha, alone or in combination, do not teach or suggest each and every limitation of Claims 2. For example, Claim 2, discloses applying an aqueous solution/dispersion of a first phenoxy-type thermoplastic resin by dip, spray, or flow coating. The Examiner has not identified the Farha or Said teach or suggest that aqueous solutions/dispersions of Phenoxy-type thermoplastics can be applied to performs. Therefore, Applicants respectfully request that the examiner withdraw the rejection and earnestly solicit the allowance of Claim 52.

Claims 53 and 55-57 depend from Claim 52 and further define the invention defined in Claim 52. Claims 53 and 55-57 are patentably distinguished over the cited claims and secondary references for at least the reasons set forth above with respect to Claim 1, as well as for novel and nonobvious features recited therein.

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### Conclusion

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding *Office Action* are inapplicable to the present claims. Any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on solely that portion; rather, patentability must rest on each claim taken as a whole. Applicants do not concede or acquiesce to any of the rejections in the *Office Action*. Applicants have not presented arguments concerning whether many of the applied references can be properly combined in view of the clearly missing elements noted. Applicants reserve the right to later contest whether a proper motivation and suggestion exists to combine the applied references. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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